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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,685	08/16/2001	Yasuhiro Tanaka	P/1071-1435	3334

7590 02/11/2003

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EXAMINER

BETTENDORF, JUSTIN P

ART UNIT	PAPER NUMBER
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2817

DATE MAILED: 02/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/931,685

Applicant(s)

TANAKA, YASUHIRO

Examiner

Justin P. Bettendorf

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly submitted claims 9 and 10 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: These claims are drawn to the species shown by Figure 12, which is patentably distinct from the other species described in the specification.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 9 and 10 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 102***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by AAPA figure 14.

In addition to the reasons of record in paper no. 8, with respect to newly added claim 7, figure 14 shows ports P1-P3 located on the margins of the ferrite.

### ***Claim Rejections - 35 USC § 103***

4. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA figure 14 in view of Kubota et al (of record).

In addition to the reasons of record in paper no. 8, with respect to newly added claim 6, the Kubota et al. reference shows electrodes 6 formed in the grooves of the device body 5 (see figure 16), which suggests forming the grooves in the ferrite of AAPA figure 14.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA figure 14 in view of Marusawa et al. JP 09-294006

As noted above, the AAPA figure 14 shows side ports P1-P3 that do not extend to the bottom surface, which has the ground conductive pattern. However, figure 14 does not show the ground conductive pattern having gaps.

Figures 2 and 4 of the Marasawa et al. reference discloses a nonreciprocal device with gaps in the ground pattern 17 where the ports extend to the bottom of the block.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to have substituted the ports that extend to the bottom of the block with a gap in the ground electrode as taught by Marusawa et al. in the nonreciprocal device of AAPA figure 14 because such a modification would have been considered a mere substitution of art-recognized equivalent side port electrodes with a corresponding ground pattern.

#### *Response to Arguments*

6. Applicant's arguments filed 11/21/02 have been fully considered but they are not persuasive.

The applicant argues that separate center electrode patterns and connecting electrodes are not shown in AAPA figure 14.

This argument is not persuasive because, although the side connecting electrodes are not labeled differently, these electrodes are clearly different from the top electrodes because they are formed on the side surfaces of the ferrite shown in figure 14.

The applicant also argues that the side electrodes are not “formed on margins of the ferrite”.

This argument is not persuasive because the meaning of “margins” includes edges such as the side surfaces of the ferrite block.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

7. In response to applicant's argument that Kubota et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Kubota et al. is from the same problem solving area, i.e. manufacturing electronic components efficiently and the same field of endeavor, which includes electronic devices. The teachings of Kubota et al. are directed to multilayer composite electronic components (see Kubota et al. col. 1, lines 10-15), which

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includes nonreciprocal devices as would have been well known to one of ordinary skill in the art.

Also, it is well known that forming multiple units from a motherboard reduces manufacturing costs.

### *Conclusion*

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

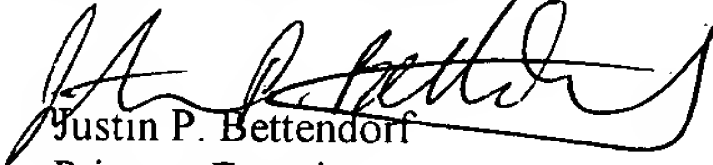
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin P. Bettendorf whose telephone number is (703) 308-2780. The examiner can normally be reached on 6:00-3:30 (M-F, 1st Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Pascal can be reached on (703) 308-4909. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

  
Justin P. Bettendorf  
Primary Examiner  
Art Unit 2817

jpb  
February 5, 2003